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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,102	08/11/2000	David C. Schwartz	960296.97133	7761
26710	7590	03/23/2004	EXAMINER	
QUARLES & BRADY LLP 411 E. WISCONSIN AVENUE SUITE 2040 MILWAUKEE, WI 53202-4497			DAVIS, DEBORAH A	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,102

Applicant(s)

SCHWARTZ, DAVID C.

Examiner

Deborah A Davis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-13 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35 is/are allowed.
- 6) ☒ Claim(s) 1,2,5-13,34 and 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants' response to the office Action mailed on January 30, 2004 has been acknowledged. Currently, claims 1-2, 5-13, 34-40 are pending, which includes newly added claims 37-40. Claims 14-33 are withdrawn. Claims 2 and 4 have been cancelled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 37-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "chemically reactive substances are exposed on the sides of the filaments" in newly added claim 37, line 5 is not supported by the instant specification. Applicant is invited to show support for this limitation.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 5, 6, 7, 9, 34, 36-38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al (USP# 4,867,946) in view of Adams et al (USP#6,156,494)

Gross et al anticipates the instant claims by teaching a device for evaluating test strips used to screen a variety of different samples. The test strips contain several test sections where the reagents are placed for testing (col. 1, 2nd para and see Figure 2). The device has a platform and a holder to support the test strips (col. 2, see claim 1) in a parallel relationship in which the test strips are perpendicular to the holder (see Figure 2). The test strip has test sections spaced along the strips to allow samples to be deposited (see Figure 2). The limitation "support frame holding the plurality of different filaments for mutual exposure to a material to be screened" as recited in claims 1, 34, and 36 will not be given patentable weight because it is intended use. With respect to the recitation of a "semi-custom array for chemical screening" in the preamble has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

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Gross et al differ in the instant invention because it does not specifically point out that the organic compounds used are from the groups of oligonucleotides and peptides and that the substrate is of glass fiber.

However, Adams et al teaches methods for utilizing optical fibers as a solid support for the assembly of combinatorial compounds. The optical fibers are used to direct light, heat or a combination thereof (see abstract). Adams et al discloses that optical fibers can be used to screen organic compounds, utilizing them in combinatorial libraries that include oligomeric and small molecules (column 3, lines 65-67 and column 4, lines 1-9).

It would have been obvious to one of ordinary skill in the art to modify the teaching of Gross et al to include the screening of organic material such as peptides and oligonucleotides on glass fibers as taught by Adams et al to direct heat and light or a combination thereof to compounds on the surface of the fibers (see abstract) so compounds can be screened for binding activity.

6. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al in view of Bensten et al (USP#6,372,895).

The teachings of Gross et al are set forth above and differ in the instant invention because it does not teach strips that include a marker selected from the group of printing and fluorescent material nor the use of organic compounds.

However, Bentsen et al teaches in one of his embodiments an apparatus that uses a test strip that contains a printed barcode wherein the printed material on the

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barcode has an enzyme or spore. The strip is further sterilized and dipped into a buffer solution containing Fluorescence Enzyme Substrate (FES). If enzyme activity is present, the printed pattern will become detectable (col. 20, lines 66-67 and col. 21, 1st para).

It would have been obvious to one of ordinary skill in the art to have incorporate the printed barcode as taught by Bentsen et al into the strips of Gross et al to detect enzyme activity.

Response to Arguments

7. Applicant's arguments with respect to the oligonucleotides being placed on glass beads attached to the ends of glass fibers as taught by Stupenagel et al versus oligonucleotides being spaced along the fibers in a linear fashion as taught by the instant invention are different is found persuasive but are moot in view of the new ground(s) of rejection.

Conclusion

Allowable Subject Matter

9. Claims 8, 35 and 39 are allowed.

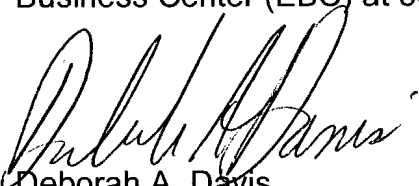
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10. Claims 8 and 39 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A Davis whose telephone number is (571) 272-0818. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deborah A. Davis
Remsen Bldg, Room 3D58
March 16, 2004


LONG V. LE
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03/19/04